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10/664,473

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Carey E. Garibay

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EXAMINER

AGWUMEZIE, CHARLES C

ART UNIT

PAPER NUMBER

3685

MAIL DATE

DELIVERY MODE

03/12/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/664,473	Applicant(s) GARIBAY ET AL.	
	Examiner CHARLES C. AGWUMEZIE	Art Unit 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-129 is/are pending in the application.
- 4a) Of the above claim(s) 19-66, and 68-119, is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18, 67-76 and 120-129 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>see continuation</u> . | 6) <input type="checkbox"/> Other: _____ |

09/17/03; 03/11/05; 05/26/06; 01/17/07; 08/06/07; 10/31/07; 02/27/08; 05/23/08; 06/19/08; 08/21/08; 09/17/08 and 12/24/08

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 24, 2008 has been entered.

Acknowledgment

2. Applicants' amendment filed on December 24, 2008 is acknowledged. Accordingly claims 1-9, 10-18, 67-76, and 120-129, remain pending.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. **Claims 1-9, 67-76, and 120-129**, are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedent¹ and recent Federal Circuit decisions, § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

(2) transform underlying subject matter (such as an article or materials) to a different state or thing.² If neither of these requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. § 101. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

In this particular case, claims 1-9, 67-76, and 120-129 fails both prong (1) because the “tie” (e.g. maintaining digital records of software licenses) is representative of extra-solution activity and/or not tied to any particular machine or apparatus. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing. Accordingly these claims are directed to non-statutory subject matter.

² The Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. **Claims 1-9, 10-18, 67-76, and 120-129**, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification as originally filed contains no support for “wherein at least one unselected license of the current licenses displayed on the page is not upgraded or downgraded”. There are new claims without support in the specification. This is the first instance of this invention that is unrelated and unsupported by the original filing. Cancellation of the new matter is required.

Applicant's amendments/arguments filed December 24, 2008 have been considered but are deemed without merit since the applicant argues an invention lacking support in the specification and based entirely on new matter.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. **Claims 1-9, 10-18, 67-76, and 120-129**, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. As per **claims 1, 10, 67, and 120**, it would be unclear to one of ordinary skill in the art to understand the technical meaning of “wherein at least one unselected license of the current licenses displayed on the page is not upgraded or downgraded” How does an unselected license be upgraded or downgraded. If it is not selected for either upgrade or downgrade why then is it going to be upgraded or downgraded. Thus the limitation adds nothing the claimed method steps.

10. As per **claim 10**, claim 10 is directed to a structure (a license management system) and a method of using the structure. It has been held that a claim that recites both an apparatus and a method for using said apparatus is indefinite under section 112, paragraph 2, as such a claim is not sufficiently precise to provide competitors with an accurate determination of the 'metes and bounds' of protection involved *IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990)

A single claim which purports to be both a product or machine and a process is ambiguous and is properly rejected under 35 USC 112, second paragraph, for failing to particularly point out and distinctly claim the invention. *Ex Parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990).

11. As per **claim 120**, claim 120 recites a computer readable media comprising software to instruct a computer to do the steps of instead of a computer program

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embodied in a computer readable medium that when executed causes the computer to ... Applicant is reminded that a computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical “things.” They are neither computer components nor statutory processes, as they are not “acts” being performed See MPEP 2106.01

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. **Claims 1-8, 10-17, 67-76, and 120-129**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Aldis et al U.S. Patent Application Publication No.

2004/0039916 A1 in view of Ross et al U.S. patent No. 5,553,143 and in view of Stupek Jr. et al (hereinafter “Stupek”) U.S. Patent No. 5,960,189 and further in view of Erickson U.S. Patent Application Publication No. 2004/0210765 A1.

14. As per **claim 1, 10, 67, and 120**, Aldis et al discloses a method comprising:
maintaining digital records of software licenses, the digital records indicating rights associated with software licenses (0005; 0015; 0121);

under the control of a software user, upgrading or downgrading the software version for multiple software licenses in a batch mode, an indication of the upgrade or downgrade being stored in the digital record wherein the multiple software licenses are individually selectable by the software user (see abstract (see figs. 4 and 5; "license packs"; Aldis teaches that the digital license can be distributed in a license pack. That a license pack contains one or more digital licenses. Arguably a license pack is equivalent to the multiple software licenses in a batch mode as claimed by present invention, see figs. 4 and 5; 0008; 0010; 0011; 0019; 0139; 0070; "license packs").);

15. What Aldis does not explicitly disclose is:

wherein the upgrading or downgrading of the software licenses includes displaying a page that shows current licenses to the user and receiving from the user an indication of what current licenses are selected to upgrade or downgrade, as well as an indication to upgrade or downgrade the selected licenses in the batch mode, the upgrading and downgrading involves providing new license keys for the upgrade/downgrade version, as well as disabling the license keys for the old versions;

wherein the page wherein the page allows for the user to select a group of more than one of the displayed current licenses for upgrading or downgrading in the batch mode, the selection of the group determining which licenses are upgraded or downgraded;

wherein at least one unselected license of the current licenses displayed on the page is not upgraded or downgraded;

wherein the licenses are selected in a batch mode from a license search page.

16. Alternatively Ross et al discloses a method comprising: under the control of a software user, upgrading or downgrading the software version for multiple software licenses in a batch mode, an indication of the upgrade or downgrade being stored in the digital record (see abstract; col. 1, line 65-col. 2, line 15, which discloses that one or more licenses in a batch of licenses can be enabled to create a software license; col. 30-35; col. 4, lines 25-35; ...a batch of licenses may be anchor or upgrade licenses...);

17. Stupek Jr. et al discloses the method comprising:

wherein the upgrading or downgrading of the software licenses includes displaying a page (window list box 51 is displayed to the user, fig. 6) that shows current licenses to the user (shows current version, fig. 9) and receiving from the user an indication of what current licenses are selected to upgrade or downgrade, as well as an indication to upgrade or downgrade the selected licenses in the batch mode, the upgrading and downgrading involves providing new license keys for the upgrade/downgrade version, as well as disabling the license keys for the old versions (see fig. 5; “can the user select this package for upgrade”; fig. 6, “list box displayed to the user”; see also figs. 9 and 10, installed version 2.30, newest version 2.40; col. 4, lines 45-55, which discloses “when the upgrade advisor 11 and/or user have selected the network resources 3 that need to be upgraded”; see col. 6, line 60-17, which discloses “package can be displayed to the user through a user interface”; col. 9, lines 15-40, which discloses ... display or report upgrade to the user including using color coded visual object...).

18. Erickson discloses the method comprising:

wherein the page allows for the user to select a group of more than one of the displayed current licenses for upgrading or downgrading in the batch mode, the selection of the group determining which licenses are upgraded or downgraded (0124, which discloses that given the intended minimum and licensed maximum permissions, the source work manager window displays those source works whose permissions need upgrading...the user will then select each one individually to launch a licensing transaction; 0158, which discloses to selectively obtain auxiliary permissions as required for each source work; 0159, which discloses if the user choose to obtain auxilliary permissions or to upgrade the current set displayed, A viewer style licensing transaction is initiated with the source-work's registration server; 0123);

wherein at least one unselected license of the current licenses displayed on the page is not upgraded or downgraded (see fig. 7);

wherein the licenses are selected in a batch mode from a license search page (see fig. 7E, which discloses source works display with option to request permissions for the desired licenses; 0159, which discloses ...to upgrade the current set displayed...).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Aldis et al and incorporate the method wherein the upgrading or downgrading of the software licenses includes displaying a page that shows current licenses to the user and receiving from the user an indication of what current licenses are selected to upgrade or downgrade, as well as an indication to upgrade or downgrade the selected licenses in the batch mode, the upgrading and downgrading involves providing new license keys for the upgrade/downgrade version,

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as well as disabling the license keys for the old versions; wherein the page wherein the page allows for the user to select a group of more than one of the displayed current licenses for upgrading or downgrading in the batch mode, the selection of the group determining which licenses are upgraded or downgraded; wherein at least one unselected license of the current licenses displayed on the page is not upgraded or downgraded in view of the teachings of Ross, Stupek and Erickson respectively in other to ensure that the only the desired licenses are upgraded and in addition since the claimed invention is merely a combination of old and known elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary art would have recognized that the results of the combination were predictable.

19. As per **claims 2, 11, 68, and 121**, Aldis et al further discloses the method, wherein the upgrading or downgrading of rights is associated with the license key (0019; 0070).

20. As per **claims 3, 12, 69, and 122**, Aldis et al further discloses the method, wherein the digital record is accessed using a web application (see fig. 1; 0065; 0066 0147; “web browser or API”).

21. As per **claims 4, 13, 70, and 123**, Aldis et al further discloses the method, wherein the web application uses role-based security (0005).

22. As per **claims 5, 14, 71, and 124**, Aldis et al further discloses the method, wherein digital records contain configuration information for the computer authorized to run the software (0010; 0072; "...hardware fingerprint of computer requesting activation code...").

23. As per **claims 6, 15, 72, and 125**, Aldis et al further discloses the method, wherein the digital records can be searched to find a specific digital record (0078; 0121; 0124; "...search and view licenses created...").

24. As per **claims 7, 16, 73, and 126**, Aldis et al further discloses the method, wherein the rights are associated with a license key (0019; 0070).

25. As per **claims 8, 17, 74, and 127**, Aldis et al further discloses the method, wherein configuration information for the computers running the software is stored in the digital record (0010; 0072).

26. As per **claims 76, and 129**, Aldis et al further discloses the method, wherein upgrading or downgrading of the version is done for multiple software licenses in a batch mode (0019; 0070; "license packs").

27. As per **claim 128**, Aldis et al further discloses the method, wherein the license version can also be upgraded (0103).

28. **Claims 9, and 18**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Aldis et al U.S. Patent Application Publication No. 2004/0039916 A1 in view of Ross et al U.S. patent No. 5,553,143 and in view of Stupek Jr. et al U.S. Patent No. 5,960,189 and Erickson U.S. Patent Application Publication No. 2004/0210765 A1 as applied to claims 1, and 10, above, and further in view of Horstmann U.S. Patent No. 6,009,401.

29. As per **claims 9, and 18**, Aldis, Ross, Stupek and Erickson failed to explicitly disclose the method, wherein the license version is downgraded.

Horstmann discloses the method, wherein the license version is downgraded (fig. 1; col. 2, line 60-col. 3, line 15).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Aldis et al and incorporate the method, wherein the license version is downgraded as taught by Horstmann in order to ensure availability of various product versions and/or user satisfaction.

Conclusion

30. Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles C. Agwumezie whose number is **(571) 272-6838**. The examiner can normally be reached on Monday – Friday 8:00 am – 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on **(571) 272 – 6709**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Charlie C Agwumezie/
Primary Examiner, Art Unit 3685

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March 9, 2009.